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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/218,916 12/22/98 NICKUM

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021186 TM02/0604  
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH  
P.O. BOX 2938  
MINNEAPOLIS MN 55402

EXAMINER

RAO, S

ART UNIT

PAPER NUMBER

2121

DATE MAILED:

06/04/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/218,916

Applicant(s)

Nickum

Examiner

Sheela Rao

Art Unit

2121



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 23, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicant's amendment filed on March 23, 2001 has been entered and considered. Claims 1, 5 and 7 have been amended and claims 14-23 have been added.
2. Claims 1-23 are presented for examination.

***Response to Amendment***

3. The objection to claim 5 is withdrawn in light of the amendment.
4. Claims 2, 3, 4, 5, 12, and 17 are objected to because of the term "the notifier". It has not been clearly stated as to what the notifier refers. For purposes of examination of the instant claims, Examiner interprets "the notifier" to be the notification transceiver. Appropriate correction is required.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-10, 12, and 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Arledge, et al. (USPN 5,561,703).

Arledge et al. teach of an automated communications system much like that of the limitations of the instant invention. The communications system of Arledge refers to applicant's

notification controller and notification transceiver as the PBX (private branch exchange) environment. As per the limitations of claims 1 and 7, column 3 at line 49 the patented disclosure states that the application servers, which includes voice mail systems, a FAX server, an Email server, and a paging server, are controlled by a host computer. This is also shown in Figure 1, however the host computer has not been shown. The external and internal telephony devices of the PBX system works as the notification transceiver of the instant invention; wherein, the external and internal telephony devices communicate between one another for receiving and transmitting messages or data for an event. The portable transceiver is identified by the end user pager which includes LED and LCD display panels. The pager of the Arledge system receives the message or data sent by the application servers and in return either displays the message and/or produces an audible signal or a vibration to indicate receipt or transmittal of the message (see column 9: lines 5-7). The existence of a software program for the method of operating the event notification system, as in claims 8-10 and 12, is inherently present as it is necessary for a computer system to encompass a software program as a means of operating a computerized system.

The use of an LED as the notifier in claim 2 is taught in column 4 at lines 13-17. The notifier consisting of an LCD panel for displaying text messages as stated in claim 3 is taught by the reference in column 4 at lines 7-10 and 17-25. The limitations of claims 4 and 5 which comprise the audible voice message and a speaker, respectively is disclosed in column 9, lines 5-7 of the reference. The integration of the notification controller and transceiver of claims 6 and 20 is taught column 3, lines 46-50.

As per claims 9 and 10, it is inherent that a software program is present in the system for an e-mail application and a fax interface as patented by Arledge since an email server and a fax server are both included. Activating a notifier as a way of alerting the user of a message as in claim 12 is taught by the prior art in column 4 at lines 7-16.

The receipt of an acknowledgment message by the notification transceiver by the portable transceiver, as in claims 19, 22 and 23, is taught in column 9 at lines 5-7. The use of the transceivers operating at a "licensed" frequency, claim 21, is inherent to the patented system.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arledge, et al. (USPN 5,561,703) as applied to claim 1 above.

The limitations of the instant invention as taught by the patented invention of Arledge is aforementioned. As with the generation of an interrupt request upon generation of an event as in claim 11, official notice is taken as it is very well known in the art to generate an interrupt request in response to an event.

Arledge teaches the claimed invention with regard to claims 1, 7, 8, and 9; however, the limitations of claims 13-18 is not explicitly taught with regard to the invention being disposed on a

computer readable medium. Examiner takes official notice that both a motive and modification would be necessary to place the invention in a computer readable media format. It would have been obvious to one of ordinary skill in the art to place computer executable instructions on computer readable medium because computer inventions are routinely stored on readable media as a means of distribution, storage, sales, transfer, security, etc. One of ordinary skill in the art would have been motivated to do this because computer programs must be stored on some type of medium in order to be executable. This is notoriously well known in the art.

For the reasons stated above in paragraphs 6 and 8, the limitations of the claimed invention is taught by the prior art of record; thereby, rendering the instant claims unpatentable.

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 11 and 13 have been considered but are moot in view of the new ground(s) of rejection.

10. The rejection of claims 1-10 and 12 under 35 USC §102(b) has been rewritten to address each of the limitations of the instant claims; thereby addressing Applicant's argument regarding the lack of a controller in the patented invention of Arledge.

#### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela Rao whose telephone number is (703) 305-9766. The examiner can normally be reached Tuesday - Thursday from 9:00 am to 3:00 pm .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Grant, can be reached on (703) 308-1108.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**  
**Washington, D.C. 20231**

or faxed to:

**(703) 308-9051 or (703) 308-6296**

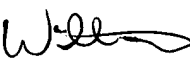
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Sheela S. Rao  
May 31, 2001

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**WILLIAM GRANT**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**  
6/1/01